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| 23911 | 7590 | 09/12/2007 | | EXAMINER |
| CROWELL & MORING LLP | | | | LUONG, VINH |
| INTELLECTUAL PROPERTY GROUP | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|---------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/537,812 | EGERTER ET AL. |
| | Examiner Vinh T. Luong | Art Unit 3682 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 July 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 13 and 15-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 13 and 15-32 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 05 July 2007 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/5/07.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application
- 6) Other: Attachments 1-3.

1. The amendment filed on July 5, 2007 has been entered.
2. The drawings were received on July 5, 2007. These drawings are accepted by the Examiner.
3. The Information Disclosure Statement (IDS) filed on July 5, 2007 has been considered. The fee set forth in 37 CFR 1.17(p) has been charged to Account No. 05-1323 per Applicant's authorization on page 3 of the IDS. This fee is necessary since the instant IDS was filed after the first Office action on March 5, 2007. See MPEP 609.05(a).
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 13 and 15-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

The term “*can be* fastened” in Claims 13 20, and 30 is vague and indefinite in the sense that things, which may be done, are not required to be done. For example, the knob can be but is not structurally required to be fastened on the control lever. See “*discardable*” in *Mathis v. Hydro Air Industries*, 1 USPQ2d 1513, 1527 (D.C. Calif. 1986), “*crimpable*” in *Application of Collier*, 158 USPQ 266 (CCPA 1968), “*removable*” in *In re Burke Inc.*, 22 USPQ2d 1368, 1372 (D.C. Calif. 1992), and “*comparable*” in *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (BPAI 1992).

6. Claims 13 and 15, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by DE 201 08 566 U1 cited by Applicant (hereinafter “DE’566).

Regarding Claim 13, DE'566 teaches a knob or grip end (FIG. 1) for a control lever (see Attachment 1 hereinafter "Att. 1") of a motor vehicle, comprising:

a knob body 2 which has a receiving device (Att. 1) for the control lever, and
a lining 1 made of a flexible material, by which the knob can be fastened on the control lever (Att. 1),

wherein the knob body 2 has a shaft part (Att. 1) and a head part (Att. 1),
which the lining 1 is formed by an elastically constructed enveloping body 1 at least partially surrounding the shaft part (Att. 1), and

wherein openings (Att. 1) are provided in a lateral surface of the shaft part (Att. 1) and are penetrated by sections of the enveloping body 1. See *Derwent Abstract* attached.

Regarding Claim 15, the openings (Att. 1) extend in axial and circumferential directions of the shaft part (Att. 1).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 13, 15, 16, 18, 21-25, 28, 31, and 32, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Fujiwara et al. (US Patent No. 6,675,670 B2 filed on February 25, 2002).

Regarding Claim 13, Fujiwara teaches a knob 5 or grip end for a control lever 2 (FIG. 1) of a motor vehicle, comprising:

a knob body 51 which has a receiving device 51a (FIG. 3) for the control lever 2, and a lining 52 made of a flexible material, by which the knob 5 can be fastened on the control lever 2,

wherein the knob body 51 has a shaft part (at 51a in FIG. 2, see Attachment 2 hereinafter "Att. 2") and a head part (Att. 2),

which the lining 52 is formed by an elastically constructed enveloping body 52 (id. col. 4, line 37+) at least partially surrounding the shaft part (Att. 2), and

wherein openings (FIGS. 2 and 3 in Att. 2) are provided in a lateral surface of the shaft part (Att. 2) and are penetrated by sections of the enveloping body 52 as seen in FIG. 3.

Regarding Claim 15, the openings (FIGS. 2 and 3) extend in axial and circumferential directions of the shaft part (Att. 2).

Regarding Claims 16 and 25, the openings (FIGS. 2 and 3) are constructed as windows, and the sections of the enveloping body 52 engage in the windows (FIG. 3), and the sections of the enveloping body 52 form ribs (Att. 2).

Regarding Claims 18 and 28, a detent device 21, 51b for axially fixing the knob 5 on the control lever 2 is provided in the head part (Att. 2) of the knob body 51.

Regarding Claims 21 and 31, outer ribs (Att. 2) extending from the shaft part (Att. 2) to the head part (Att. 2) are provided for anchoring the enveloping body 52.

Regarding Claims 22 and 23, referring the knob to the merely inferentially included or intended use element such as the control lever is not accorded patentable weight. On the other hand, Fugiwara's knob is capable of being fastened on the control lever that is flattened on both sides due to the elasticity of its materials. It is well settled that a recitation of the intended use of

the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then, it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, note that the functional limitations of a claim may not be given patentable weight where those limitations are inherent in a prior art reference. *In re Schreiber*, 44 USPQ2d 1429 (CAFC 1997).

Regarding Claims 24 and 32, Fujiwara teaches the injection molding in col. 4, line 31+. On the other hand, the patentability of a product-by-process claim does not depend on its method of production. See MPEP 2113.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 17, 26, and 27, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara.

Regarding claims 17, 26, and 27, Fujiwara's knob 51 is of a hard resin material and Fujiwara's enveloping body 52 is of an elastic material. The plastic material inherently includes resin material and the elastic material inherently includes thermoplastic synthetic material or polyurethane. The plastic and thermoplastic synthetic materials are notoriously well known in the knob or grip lever art as evidenced by the cited references. See, e.g., Foggini'718, Foggini'490, US Patent No. 4,791,826 issued to Behrens, and page 2 of GB 2 255 159 A.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the well known plastic and thermoplastic synthetic materials as the material for Fujiwara's knob and enveloping bodies in order to generate a resilient force as taught or suggested by common knowledge in the art. See *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); MPEP 2144.07; *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007); *Ex parte Smith*, 83 USPQ2d 1509 (BPAI 2007); *Ex parte Catan*, 83 USPQ2d 1569 (BPAI 2007); and *Ex parte Kubin*, 83 USPQ2d 1410 (BPAI 2007).

11. Claims 19, 20, 29, and 30, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Corbelt (GB 2 255 159 A).

Regarding Claims 19 and 29, Fujiwara teaches the invention as claimed except the detent that has snap hooks engaging in recesses provided at the control lever.

Corbelt teaches the detent that has snap hooks (at the end of the core 16 as seen in Attachment 3 hereinafter "Att. 3") engaging in recesses 19 (at the base of 19, see Att. 3) provided at the control lever 11 in order to fix the knob body 13 to the lever 11.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute Fujiwara's detent by Corbelt's detent in order to fix Fujiwara's knob body to the lever as taught or suggested by Corbelt. The results of the instant combination are predictable, i.e., to fix the knob body to the lever. *KSR International Co. v. Teleflex Inc.*, *Ex parte Smith*, *Ex parte Catan*, and *Ex parte Kubin*, *supra*.

Regarding Claims 20 and 30, Corbelt's snap hooks are equipped with ribs (Att. 3) on their exterior sides for reinforcement.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Daniel (hooks 14 in FIG. 3) and Behrens (windows 18).

13. Applicant's arguments filed July 5, 2007 have been fully considered but they are not persuasive.

DRAWINGS

The objection to the drawings is withdrawn in view of Applicant's submission of replacement sheet of drawings.

35 USC 112

Applicant contended “[t]he term ‘flexible’ is used in thousands of issued U.S. patents, while the term ‘can be fastened’ is used in hundreds of issued patents. The present of these terms in claims of the present application does not render those claims indefinite.”

The Examiner respectfully submits that it is well settled that an expert's opinion on the ultimate legal issue must be supported by something more than a conclusory statement. *In re Buchner*, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991). If the terms “flexible” and “can be fastened” in issued patents, Applicant should have cited some of these patents to support Applicant's above statement.

Assuming *arguendo* that the terms “flexible” and “can be fastened” in issued patents, Applicant has not cited any authority which holds that the issuance of a patent has significant precedential value. See *In re Gyurik*, 596 F.2d 1012, 1018 n.15, 201 USPQ 552, 558 n.15 (CCPA 1979); *In re Philips*, 315 F.2d 943, 137 USPQ 369 (CCPA 1963); and *In re Zahn*, 617 F.2d at 267, 204 USPQ at 995 (“[W]e are not saying the issuance of one patent is a precedent of

much moment.”). On the other hand, our reviewing Court in *In re Zletz*, 13 USPQ2d 1320, 1322 (CAFC 1989) stated:

An essential purpose of patent examination is to fashion claims that are *precise, clear, correct, and unambiguous*. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.

Thus, the inquiry during examination is patentability of the invention as “the applicant regards” it, and if the claims do not “particularly point out and distinctly claim”, in the words of section 112, that which examination shows the applicant is entitled to claim as his invention, *the appropriate PTO action is to reject the claims for that reason*. (Emphasis added).

In the instant case, the term “can be fastened” is ambiguous because it is unclear whether the knob body is structurally required to be fastened on the control lever. See “discardable” in *Mathis v. Hydro Air Industries*, “crimpable” in *Application of Collier*, removable” in *In re Burke Inc.*, and “comparable” in *Ex parte Anderson, supra*. See also “other terms” in MPEP 2173.05(b). Applicant is respectfully suggested to amend the term “can be fastened” to, e.g., “is fastened.”

For the foregoing, the rejection under 35 USC 112 based on the term “can be fastened” is respectfully maintained in abeyance of Applicant’s further amendment.

With respect to the term “lining,” Applicant stated “[i]t is apparent from Claim 13 that the lining specified is in fact formed by the enveloping body.”

The Examiner agrees that it is apparent from *amended* Claim 13 filed on July 5, 2007 that the lining is in fact formed by the enveloping body. However, it is not apparent from Claim 13 filed on June 7, 2005 that the lining and enveloping body are the same. Indeed, the preliminary amendment on June 7, 2005 recited:

13. A knob or grip end for a control lever of a motor vehicle, comprising: a knob body which has a receiving device for the control lever, and *a lining, made of a flexible material*, by which the knob can be fastened on the control lever.

14. The knob or grip end according to claim 13, wherein the knob body has a basic body with a shaft part and *a head part which are surrounded at least partially by an elastically constructed enveloping body*, and wherein openings are provided in a lateral surface of the shaft part and are penetrated by sections of the enveloping body. (Emphasis added).

As noted in the quoted Claims 13 and 14 above, there is no nexus between “a lining, made of a flexible material” in Claim 13 and “an elastically constructed enveloping body” in Claim 14 as filed on June 7, 2005. Therefore, it was not *precise, clear, correct, and unambiguous* that the lining is the enveloping body. See *In re Zletz, supra*.

In view of Applicant now claims that “wherein the lining is formed by an elastically constructed enveloping body” in amended Claims 13, 20, and 30, this ground of rejection is withdrawn. However, the amendment “wherein the lining is formed by an elastically constructed enveloping body” necessitated new grounds of rejections above.

ART REJECTION

Applicant’s arguments, see pages 10-12, filed July 5, 2007, with respect to the rejection(s) of Claim(s) 13, etc. under Foggini’718 and Foggini’490 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration due to the limitation “wherein the lining is formed by an elastically constructed enveloping body,” new grounds of rejection are necessitated as seen above.

CONCLUSION

In view of the foregoing, the Examiner respectfully submits that this application is not in the condition for allowance.

14. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on July 5, 2007 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley, can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Luong

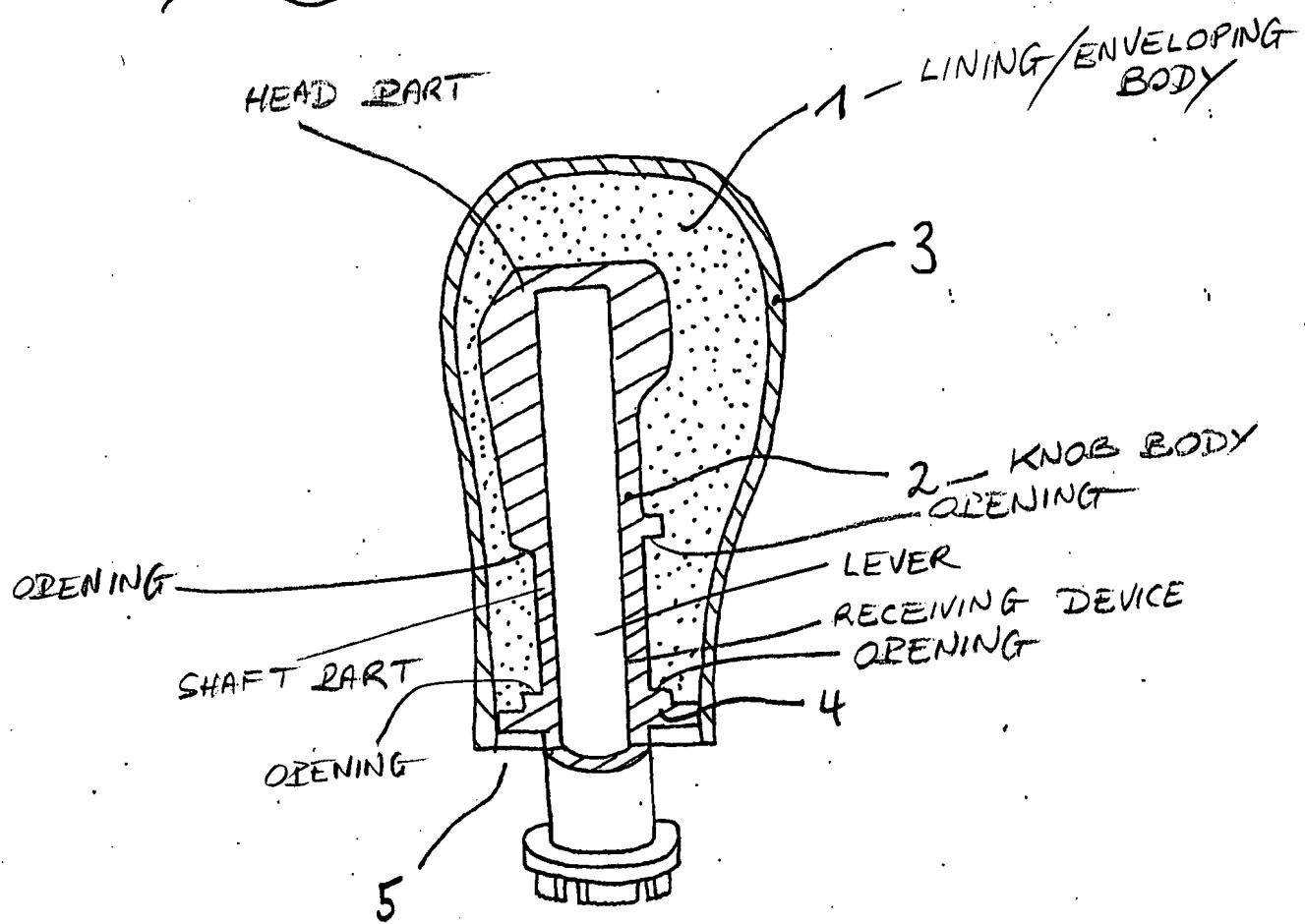
September 10, 2007



Vinh T. Luong
Primary Examiner

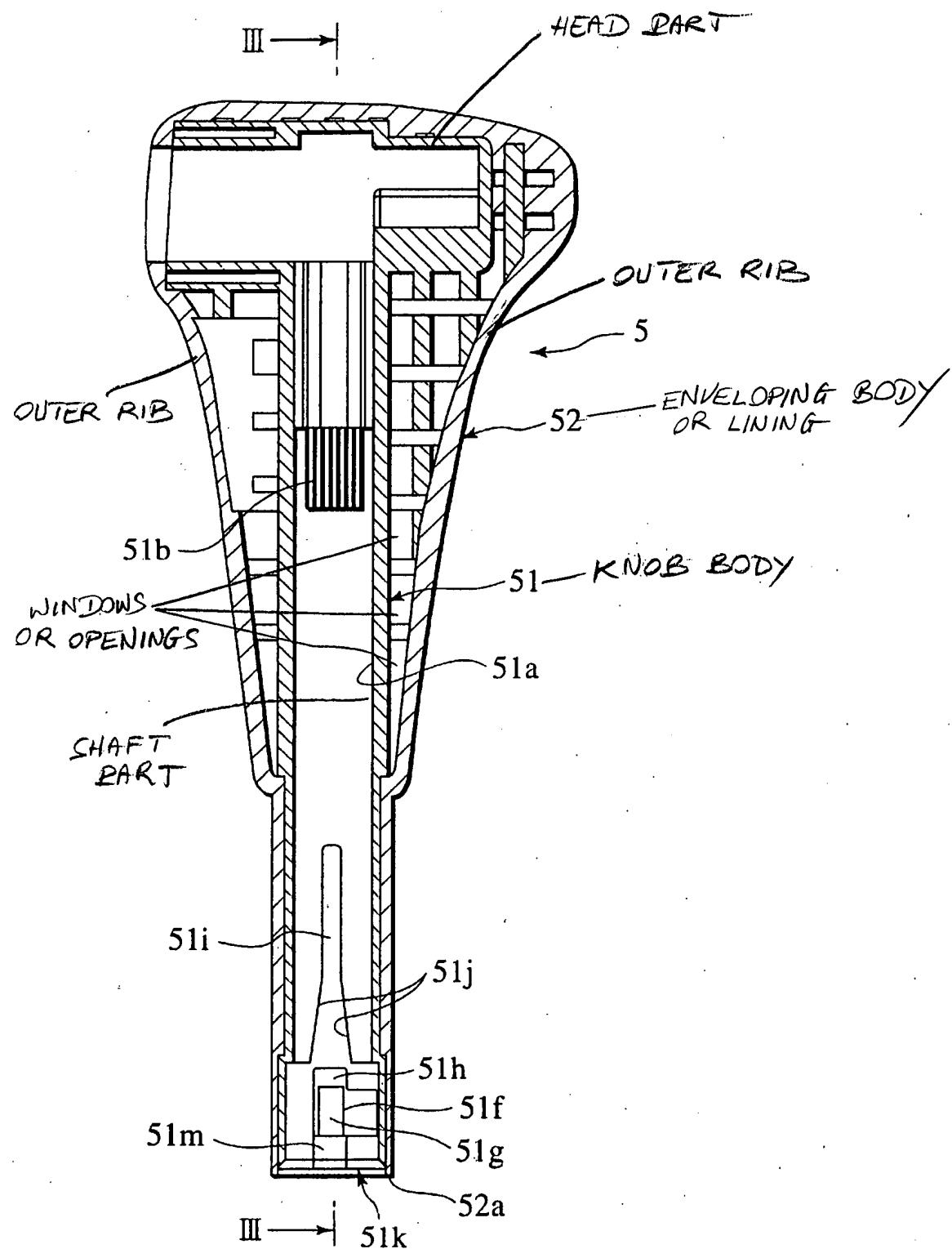
ATTACHMENT 1

Fig. 1



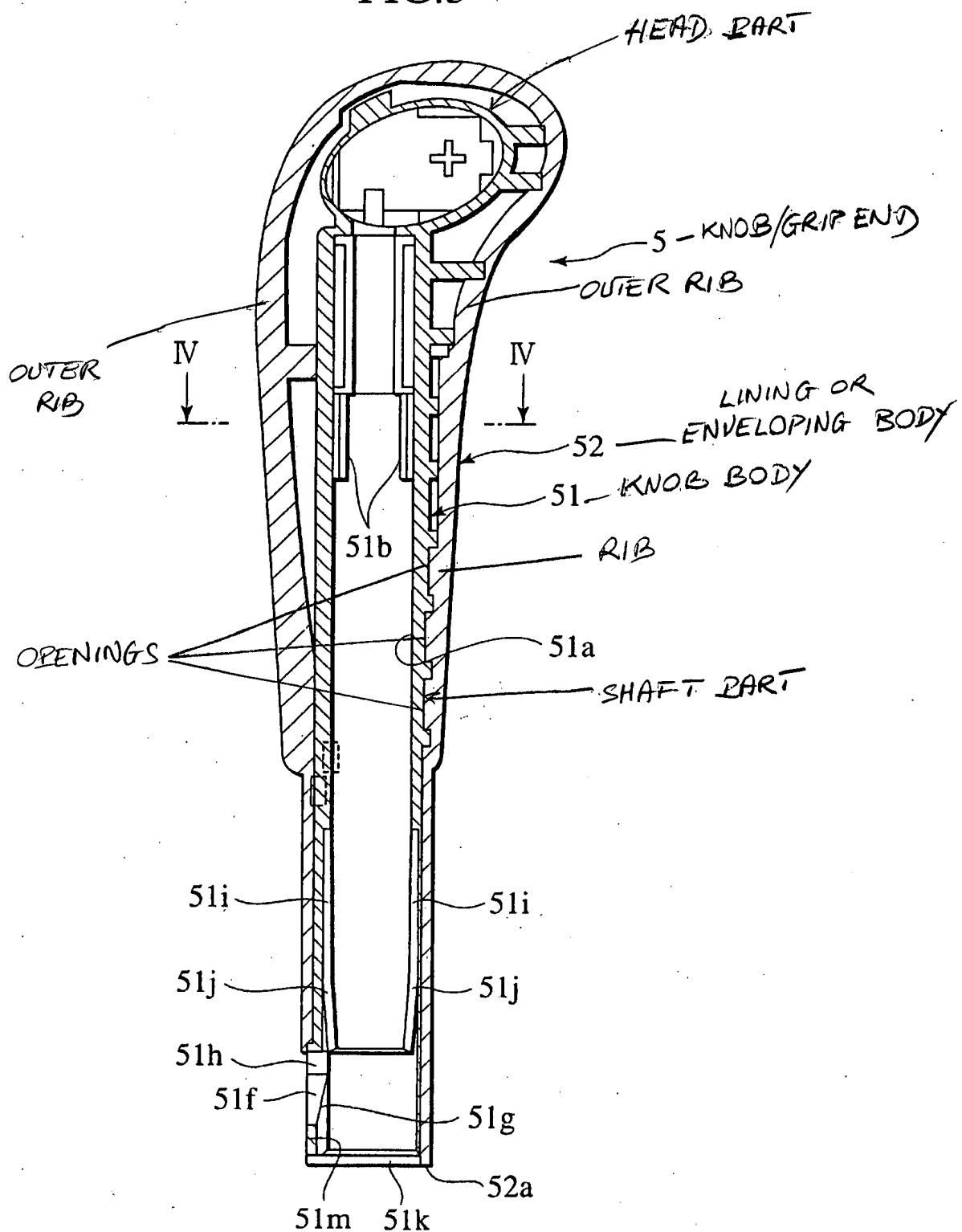
ATTACHMENT 2

FIG.2



PAGE 1 OF 2

FIG.3



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ATTACHMENT 3

